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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,487	10/27/2003	Kent J. Myers	KMY.P.0003	1972

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EXAMINER

NGUYEN, PHONG H

ART UNIT PAPER NUMBER

3724

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/692,487	MYERS, KENT J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Phong H Nguyen	3724	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10 and 13-19 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 112*

2. Claims 1-15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 15, it is unclear how a wheel biasing member pre-disposing a cutting wheel extends into a pipe slot without a counter force. The Specifications teaches a plate spring 56 (which is the wheel biasing member) urging (forcing/biasing) the cutting wheel to extend into pipe slot. See page 5, lines 18-20.

Regarding claim 17, it is unclear how a cutting wheel being pre-disposed to extend into a pipe slot without a counter force. The Specifications teaches a plate spring 56 (which is the wheel biasing member) urging (forcing/biasing) the cutting wheel to extend into pipe slot. See page 5, lines 18-20.

Claims 1-15 and 17 will be rejected based on art as best understood by the Examiner due to 35 USC 112 Rejections.

***Claim Rejections - 35 USC § 102***

3. Claims 1-6, 13-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazarevic (6,065,212).

Regarding claims 1-3, Lazarevic teaches all the recited elements of the invention including a pipe cutter device comprising a rotary head 16, a housing gear, a pipe slot, a pipe cradle, a cutting wheel 37, wheel biasing members (17, 18), a drive source 26 and a gear system comprising a prime gear 64, a first drive gear 61 and a second drive gear 62. See Figs. 1-18.

Regarding claim 4, a slot-engaging gear 31 having teeth and a protrusion 67 extending beyond the teeth of the slot-engaging gear and engaging a portion of the pipe slot during each rotation of the slot-engaging gear and the housing gear is best seen in Fig. 1. The protrusion 67 is mounted on an area that is a part of the pipe slot.

Regarding claim 5, the wheel biasing member (17, 18) is best seen in Fig. 1.

Regarding claim 6, Lazarevic teaches the cutting wheel 37 extending from a shaft (42, 38) that extending into a wheel slot (formed by element 17, 18) within the rotary head and the plate spring member contacting the shaft to urge the shaft inwardly in the wheel slot. See Figs. 1-5, 10 and 11.

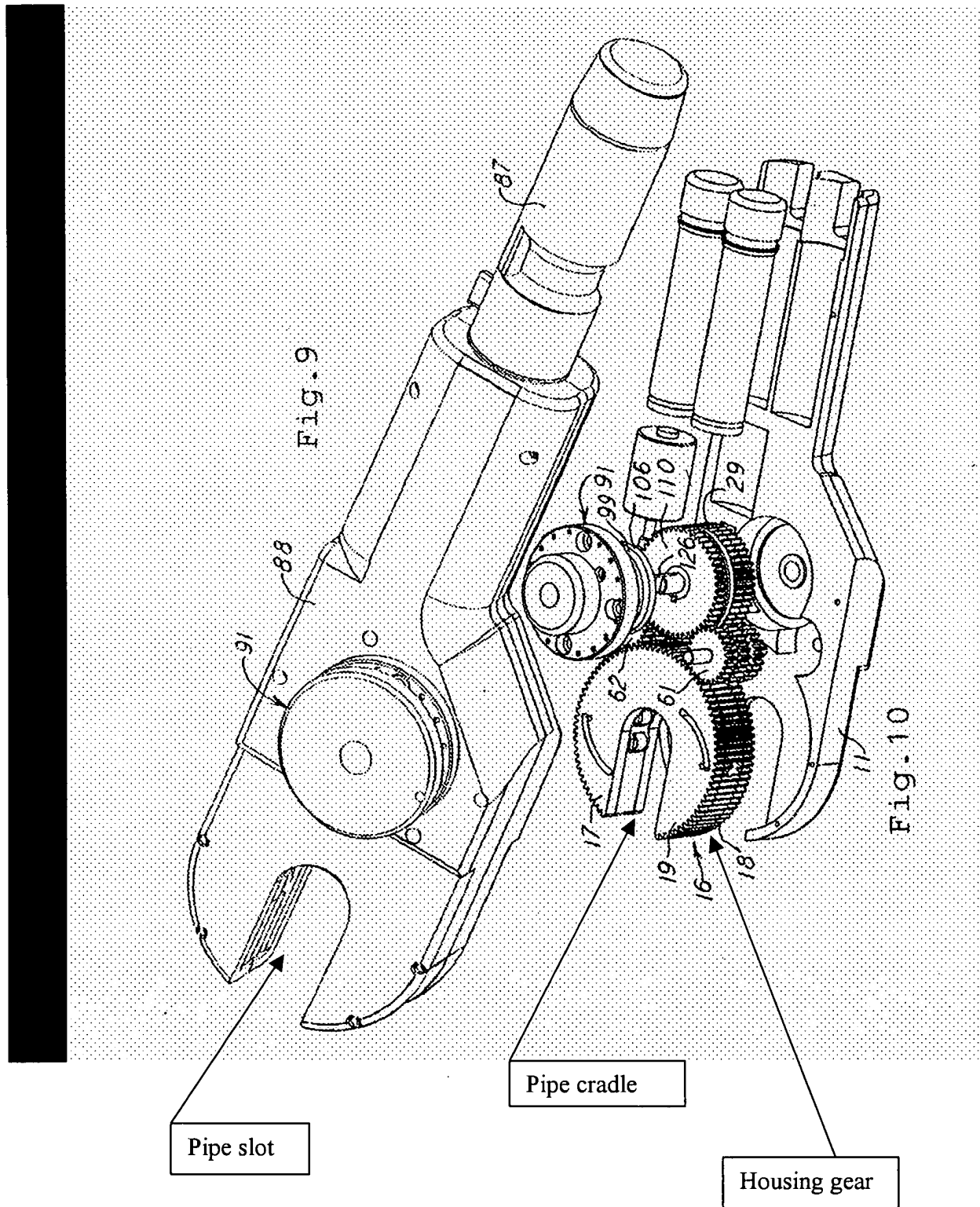
Regarding claim 13, two freewheeling support rollers 52 are best seen in Figs. 6, 11, 16 and 18.

Regarding claim 14, an adjustable block 46 is best seen in Fig. 11.

Regarding claim 15, pipe-engage-surfaces 52 are best seen in Fig. 11, 16 and 18.

Regarding claim 16, Lazarevic teaches all the recited elements of the invention including a pipe cutter device comprising a rotary head 16, a housing gear, a pipe slot, a pipe cradle, a cutting wheel 37 and a slot-engaging gear 31. See Figs. 1-18.

Regarding claim 18, Lazarevic teaches all the recited elements of the invention including a pipe cutter device comprising a rotary head 16, a housing gear, a pipe slot, a pipe cradle, an extending wheel slot within the rotary head (formed by elements 17, 18), a cutting wheel 37, a wheel biasing member (17, 18) and a retraction hook (57, 58). See Figs. 1-18.



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4. Claims 1-3, 5-7, 10, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by VanderPol et al. (4,890,385).

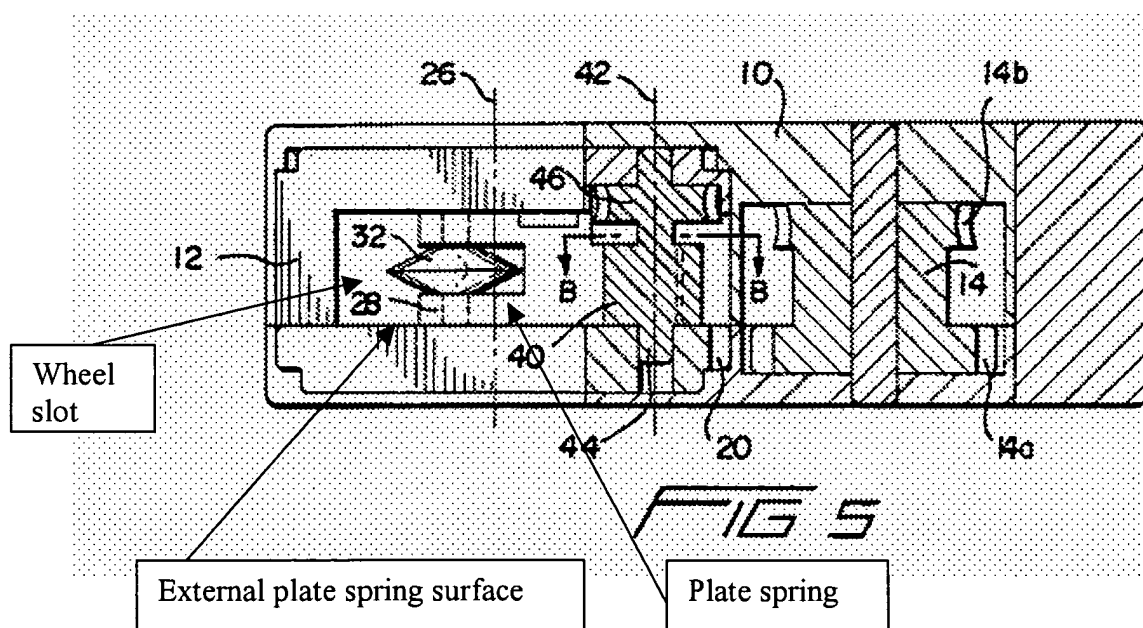
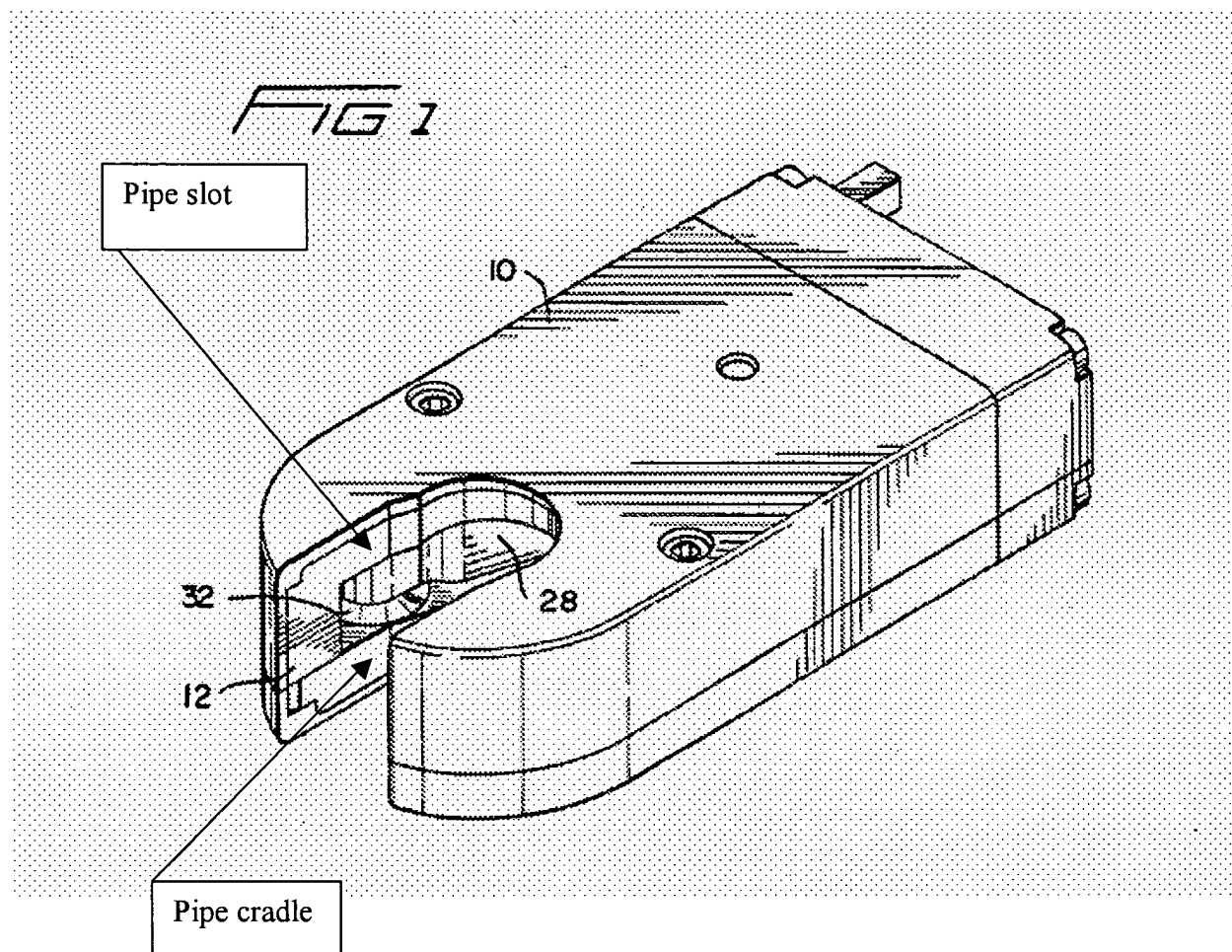
Regarding claims 1-3 and 16, VanderPol et al. teach all the recited elements of the invention including a pipe cutter device comprising a rotary head 12, a housing gear 20, a pipe slot, a pipe cradle, a cutting wheel 32, a wheel biasing member comprising elements 28, 30 and 36 and a drive source inherently in the pipe cutting assembly. See Figs. 1-8.

Regarding claims 5, 6 and 7, the wheel-biasing member comprising two plates 28 to form a slot therein for receiving the cutting wheel and the spring 28 for disengaging the cutting wheel from the pipe is considered as a plate spring member since it performs the same claimed functions. The plates 28 support the shaft of the cutting wheel and the spring 28 urges the shaft via the plates 28. See Figs. 2, 4 and 5.

Regarding claim 10, the spatial relationship of the rotary head and the plate spring member is best seen in Fig. 5.

Regarding claim 19, VanderPol et al. teach all the recited elements of the invention including a pipe cutter device comprising a rotary head 12, a housing gear 20, a pipe slot, a pipe cradle, a cutting wheel 32 extending from a shaft, a plate spring member (the portion from the cutting wheel 32 to a pin 30 of an element 28) contacting a shaft to urge the shaft inwardly in a wheel slot, a retraction plate (the rest of the element 28) and a retraction rod 30. See Fig. 2.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarevic (6,065,212).

Lazarevic teaches all the recited elements of the invention including a pipe cutter device comprising a primary drive source 26, a rotary head 16, a housing gear, a pipe slot, a pipe cradle and a cutting wheel 37. See Figs. 1-18. Lazarevic fails to teach the pipe cradle being sized to receiving pipes with different diameters. Providing an appropriate pipe cradle size for a user to choose is routine skill in the art. Therefore, it would have been obvious to one skill in the art to provide rotary heads with different pipe cradle sizes so that a user can choose to work on pipes with different sizes since it is routine skill in the art.

***Allowable Subject Matter***

7. Claims 8, 9, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed on 10/18/2004 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the limitation of "the wheel biasing member" in claim 1, "the slot-engaging gear" in claims 4 and 16, and "the plate spring member" in claims 5-7 have been considered but they are moot in view of new grounds of rejection. Those limitations can be interpreted differently from the Specification due to broad claim language. Applicant is suggested to put more structural languages to overcome the prior art.

The subject matter of claims 8, 9, 11 and 12 in the newly added independent claims 18 and 19 is not allowable since claims 18 and 19 do not include all of the limitations of the base claim and the intervening claims.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

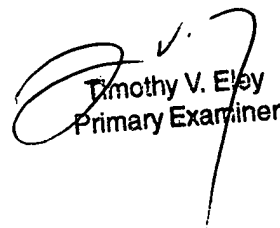
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN:



January 5, 2005



Timothy V. Eley  
Primary Examiner